PATENT
ATTORNEY DOCKET NO.: **LEAPS-C11**
CUSTOMER NO: 36038

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: M. Seul	)	
	)	Group Art Unit: 1641
Serial No. 10/645,426	)	
	)	Examiner: Do, Pensee T.
Confirmation No. 8876	)	
Filed: 6/21/2003	)	
For: Arrays Formed of Encoded Beads Having Ligands Attached	)	

Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

Supplemental Brief

Dear Sir:

Applicants would like to supplement the Brief on Appeal in this matter by including the Related Proceedings Appendix which follows, with the Brief. The Appendix refers to a recent decision in a pending related application Serial No. 10/424,662.

Respectfully Submitted,

By: /EPM/
Eric P. Mirabel; Reg. No. 31,211
(908) 226 8200 (ext 203)

Related Proceedings Appendix

The Opinion in Serial No. 10/424,662 follows.

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Ex parte MICHAEL SEUL

Appeal 2007-1624

Application 10/424,662

Technology Center 1600

Decided: September 13,2007

Before ERIC GRIMES, NANCY J. LINCK, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges.*

LEBOVITZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 76-86, 89, 90 and 105-108. We have jurisdiction under 35 *U.S.C.* § 6(b). We reverse the written description and prior art rejections, but affirm the rejection under § 112, second paragraph. We also reject claims 76-81,84-86, 88, 89, 90, 105, 106, 107, and 108 under a new ground of rejection.

STATEMENT OF CASE

The appealed claims are directed to an array of oligonucleotides in which the oligonucleotides are attached to particles (also referred to as "beads, 1) arranged on a substrate in a planar configuration. The following rejections are on review in this appeal:

1) Claims 77-86, 88, 89, and 105-108 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description

requirement (Answer 3);

2) Claim 79 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Answer 4);

3) Claims 77-81, 84, 85, 88, 89, 105, 106, and 108 stand rejected under 35 U.S.C. § 102(e) as anticipated by Fodor (US 5,800,992, filed Dec. 15, 1993) (Answer 4);

4) Claim 86 stands rejected under 35 U.S.C. § 102(e) as anticipated by Fodor as defined in Pirrung (US 5,143,854, filed Mar. 7, 1990) (Answer 7);

5) Claims 76 and 106 stand rejected under 35 U.S.C. § 102(e) as anticipated by Fodor, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Fodor (Answer 9);

6) Claim 90 stands rejected under 35 U.S.C. § 103(a) as being obvious over Fodor in view of Drmanac (EP 0392546 A2, published Oct. 17, 1990) (Answer 11); and

7) Claims 82, 83, and 107 stand rejected under 35 U.S.C. § 103(a) as being obvious over Fodor in view of Eggers (US 5,532,128, issued Jul. 2, 1996) (Answer 13).

Claims 76, 77, and 90 are representative of the subject matter on appeal:

1 Spec. 8: 14.

76. An array of oligonucleotides comprising oligonucleotides of differing sequences, wherein said differing oligonucleotides are attached to different particles arranged on a defined area of a substrate in a planar configuration, said particles being encoded with a chemical or physical characteristic that allows identification of the oligonucleotide attached thereto, and wherein said particles are permanently anchored to said substrate.

77. An array of oligonucleotides and a contiguous aliquot of solution containing analytes in contact said array, said array

comprising oligonucleotides of differing sequences, wherein said differing oligonucleotides are attached to different particles wherein said particles are encoded with a chemical or physical characteristic that allows identification of the oligonucleotides attached thereto, wherein said particles are arranged on a substrate in a planar, spatially nonrandom but compositionally random configuration, and said aliquot is placed on said planar configuration.

90. An array of oligonucleotides prepared by a method comprising the following steps:

providing a multiplicity of reservoirs arranged in a predetermined layout, wherein each of said reservoirs has a known position within the layout and contains a plurality of different types of particles having a different oligonucleotides attached thereto and each of said particle types being encoded with a chemical or physical characteristic that uniquely identifies said particle type and oligonucleotide attached thereto, and wherein the known positions of the reservoirs within the layout in combination with the encoding indicate the types of particles contained therein; and transferring said suspensions of particles from the reservoirs onto a substrate in a layout preserving manner and forming a multiplicity of planar particle arrays on said substrate, such that the particle types of each particle array are identical to the particle types of the corresponding reservoir and the position of each of the particle arrays on said substrate correlates with the position of the corresponding reservoir.

FINDINGS OF FACT

Fodor

1. Fodor describes positionally attaching oligonucleotides to a substrate to produce "substrates of positionally definable sequence specific probes"

(Fodor, at col. 3, 11.49-53).

2. "Usually the specific reagents are all attached to a single solid substrate, and the reagents comprise about 3000 different sequences. . . . Usually, the reagents are localized in regions of the substrate having a density of at least 25 regions per square centimeter" (Fodor, at col. 3, 11.6-13).

3. Fodor also describes an embodiment in which the substrates are beads (Fodor, at col. 3, 158).

4. Each bead can have a single oligonucleotide probe type ("reagent") attached to it (Fodor, at col. 4, 11.1-4; at col. 21, 11.42-43).

5. The beads may be "encoded to indicate the subsequence specificity of [the reagent on the bead]" (Fodor, at col. 21, 11.44-46).

6. "[T]he target [polynucleotide] may be bound to the whole collection of beads and those beads that have appropriate specific reagents [e.g., oligonucleotides] on them will bind to the target. Then a sorting system may be utilized to sort those beads that actually bind the target from those that do not" (Fodor, at col. 21,11.48-54).

7. After the beads "which have bound the target have been collected, the encoding scheme may be read off to determine the specificity of the reagent on the bead. An encoding system may include a magnetic system, a shape encoding system, a color encoding system, or a combination of any of these, or any other encoding system" (Fodor, at col. 21, 11.54-60).

8. Claim 2 of Fodor is directed to a method of detecting nucleic acid sequences using an array of polynucleotides bound to a solid support, where "the solid support comprises an array of beads" (Fodor, at col. 82, 11.49-50).

9. When a single substrate surface is utilized (Findings of Fact ("FF") FF 1; Fodor, at col. 3,11.6-13), the positional attachment of oligonucleotides to the solid substrate surface is necessary to determine which sequences are present in the target DNA (e.g., Fodor, at col. 2, 11.35-39; col. 3, 11.19-29; and col. 19,11.20-32).

Pirrung

10. Pirrung describes determining signal detection capability of fluorescent

beads (col. 26,11. 11-45). "One of the beads was placed in the illumination field on the scan stage. . . in a field of a laser" (Pirrung, at col. 26, 11.18-21).
11. The laser beam was directed at the bead and the resulting fluorescence was measured (Pirrung, at col. 26, 11.20-29).
12. The bead utilized in the assay described by Pirrung (col. 26) did not contain attached DNA and was not arranged with other particles to form an oligonucleotide array.
13. There is no teaching in Pirrung that the particles with attached DNA can be arranged on a substrate in a planar configuration.

DISCUSSION

Rejection under § 112, *first paragraph*

Claims 77-86, 88, 89, and 105-108 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Answer 3).

The Examiner contends that there is no support in the Specification for the phrase "a contiguous aliquot of solution containing analytes" which was added by amendment to claim 77 (Answer 3). According to the claim, the aliquot is "placed on said planar configuration" of the oligonucleotide array.

Appellants contend that Example IV, pages 25-27, of the Specification describes "a contiguous liquid phase," and when read along with Fig. 6, provides support for the phrase (Br. 4).

We agree with Appellants. As conceded by the Examiner, the Specification describes a liquid phase that is contiguous with the array (Answer 3). The Examiner asserts that a "contiguous liquid phase" is different from a "contiguous aliquot of solution," but does not explain the *2 The Random House College Dictionary* 35 (1982).

difference (Answer 3-4). In our opinion, there is none.

An "aliquot" is defined as a "definite part of a whole. In Example IV, drops of a solution - which can be characterized as "parts" of the

solution or "aliquots" - are deposited on the substrate (Spec. 25: 23-32). The droplets are fused to form a "contiguous liquid phase" (Spec. 26: 5-8) of the solution. Thus, the Specification describes contiguous droplets (the "aliquot") in contact with the oligonucleotide array, providing support for the phrase "a contiguous aliquot of solution containing analytes."

The Examiner also contends that there is no support for the phrase "hybridize. . . under appropriate conditions" which was added by amendment to claim 78 (Answer 3-4). The Examiner asserts: "While hybridization conditions are well know and varied in the art, 'appropriate conditions' for a *novel* array may vary from other arrays known in the art. The specification does not teach or describe the conditions that would be 'appropriate' for the claimed array. Therefore, the recitation introduces new matter into the specification" (Answer 4).

We disagree.

"The descriptive text needed to meet [the written description requirement] . . . varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence." *Capon v. Eshhar,* 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005). In this case, the Specification discloses conditions which affect hybridization (Spec. 42: 28-31). Persons of skill in the art would have been familiar with the "appropriate" conditions necessary to accomplish hybridization. Thus, it is unnecessary to describe the specific hybridization conditions used with the claimed oligonucleotide array. The Examiner has provided no evidence that these conditions would be different for the claimed array of particles. Accordingly, we conclude that the Specification describes that "the oligonucleotides hybridize . . . under appropriate conditions" as recited in claim 78.

For the reasons discussed above, we reverse the rejection of claims 77-86,88,89, and 105-108 as failing to comply with the written description requirement.

Rejection under § 112, *second paragraph*

Claim 79 stands rejected under 35 *U.S.C.* § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Answer 4).

The Examiner contends that claim 79 "is indefinite for the recitation 'the target oligonucleotides' because the recitation lacks proper antecedent basis in Claims 76 and 77" (Answer 4). Appellants do not address the rejection in their Brief or Reply Brief. Accordingly, we summarily affirm the rejection of claim 79 under 35 *U.S.C.* § 112, second paragraph.

Rejections under §§ 102 and 103

We consider the rejections over Fodor (Answer 4 and 9), Fodor as defined in Pirrung (Answer 7), Fodor in view of Drmanac (Answer 11), and Fodor in view of Eggers (Answer 13) together because each depends on the correctness of the Examiner's findings that Fodor describes particles arranged on a substrate in a planar configuration as recited in both claims 76 and 77. As explained in more detail below, it is our opinion that that the Examiner erred in her findings.

Fodor describes two embodiments for detecting nucleic acids. In the first embodiment, different oligonucleotides are attached to the same solid substrate at spatially defined positions (FF 1,2). This configuration is now generally referred to as a DNA or gene chip, where a single surface can have as many as 3000 different oligonucleotides attached to it (FF 2). The second embodiment described in Fodor uses beads for nucleic acid detection (FF 3). In contrast to the DNA chip, each bead contains a single probe type (FF 4). When beads are utilized, Fodor describes binding the target DNA to the beads and then sorting the beads to determine which contain bound target DNA (FF 6).

We do not see any disclosure in Fodor that describes or suggests placing the beads in a planar configuration on a substrate as required by claims 76 and 77. In the DNA chip embodiment, the positional attachment of oligonucleotides to the solid substrate surface is necessary to determine which sequences are present in the target DNA (FF 9). However, as argued

by Appellants (Br. 5), Fodor does not describe positional attachment as a way of determining sequence binding when beads are used. Instead, Fodor states that the sequence specificity of the bead is determined by information encoded directly in the bead, itself (FF 5, 7). Thus, the fact that in the first embodiment the oligonucleotides are attached to a solid support in a planar configuration does not imply or suggest that the beads are arranged in the same configuration.

The Examiner asserts that Pirrung, referenced in Fodor, describes particles on an upper surface (Answer 7-8). At column 26, lines 11-45, Pirrung describes determining signal detection capability of fluorescent beads. "One of the beads was placed in the illumination field on the scan stage. . . in a field of a laser" (FF 10). The laser beam was directed at the bead and the resulting fluorescence was measured (FF 11). This example was for the purpose of demonstrating signal capability. The bead utilized in the assay described at column 26 of Pirrung did not contain attached DNA and was not arranged with other particles to form an oligonucleotide array (FF 12). There is no teaching in Pirrung that the particles with attached DNA be arranged on a substrate in a planar configuration (FF 12), as required by claims 76 and 77, for detection purposes. Thus, we conclude that the Examiner's findings are erroneous.

The Examiner also argues that "Fodor specifically teaches and claims 'an array of beads' (Column 3, lines 45-Column 4, line 4 and Claim 2)" (Answer 8). Apparently, the Examiner has interpreted the statement in claim 2 of Fodor that the "solid support comprises an array of beads" to mean that the beads are arranged on the solid support in a planar configuration. We do not agree with this interpretation of Fodor. As we understand Fodor's disclosure, the solid support (referred to also as "solid phase substrate") can be: 1) a matrix supporting a high density of different probes or 2) a bead that typically only contains one probe. In this context, the phrase in claim 2 that the "solid support comprises an array of beads" does not mean that beads are layered on a solid support, but rather means that the beads serve as a solid

support. In addition, we do not see any evidence of record that the term "array," itself, indicates that the beads are arranged in a planar configuration as recited in claims 76 and 77.

In sum, we conclude that the Examiner erred in finding that Fodor describes or suggests oligonucleotides attached to different particles, wherethe particles are arranged on a substrate in a planar configuration as recited in claims 76 and 77. For this reason, we reverse the rejections of claims 77-81,84,85,88,89,105, 106, and 108 as anticipated by Fodor, of claim 86 as anticipated by Fodor as defined by Pirrung, and of claims 76 and 106 as anticipated, or in the alternative, as obvious, over Fodor. We also reverse the rejections of claim 90 as obvious over Fodor in view of Drmanac and claims 82, 83, and 107 as obvious over Fodor in view of Eggers, each of which depend on the Examiner's erroneous finding that Fodor describes particles arranged on a substrate in a planar configuration.

NEW GROUND OF REJECTION

Pursuant to 37 C.F .R. § 41.50(b), we set forth the following new ground of rejection:

Claims 76-81,84-86,88-90, and 105-108 are rejected under 35 D.S.C. § 102(b) as anticipated by Drmanac.

FINDINGS OF FACT

Drmanac

14. Drmanac describes the use of a solid particle ("discrete particle" or "DP") carrying multiple copies of the same DNA fragment for use in detecting DNA (Drmanac, at col. 7,11.5-14).

15. To produce a collection of discrete particles carrying DNA genomic fragments, a library of genomic clones is first distributed into microtiter wells (Drmanac, at col. 7, 11.22-23).

16. The genomic DNA can be derived from a human (Drmanac, at col 1, 11. 11).

17. Instead of genomic DNA, oligonucleotides probes ("ONPs") can also be

attached to the DP (Drmanac, at col. 8, 11.35-38).

18. Skilled persons in the art would have recognized that a genomic library is a collection of random genomic clones representing the organism's entire genome.

19. Discrete particles are added to each well and the DNA is permitted to attach to the particles (Drmanac, at col. 7, 11.23-25).

20. "Aliquots of DPs from each well are mixed together and spread in the monolayer of required density. This is followed by the necessary number of fixations" (Drmanac, at col. 7, 11.27-30).

21. "In this way one can obtain hybridization areas (HA) similar to filters in dot blot procedure" (Drmanac, at col. 7, 11.30-31; *see* also Drmanac, at col. 9, 11. 12-16).

22. "Every HA can in principle by hybridized and reused as classic filters" (Drmanac, at col. 7, 11.37-39).

23. The DPs can be labeled with physical attributes or with unique combinations of oligonucleotides so that they can be recognized and distinguished from each other (Drmanac, at col. 7, 1.45 to col. 8, 1.21; at col. 13,11.40-45).

24. The exact position of each DP in the hybridization area, and the corresponding oligonucleotide probe ("ONP") attached to the DP, can be established (Drmanac, at col. 9, 11.19-31 ("By the hybridization of OHAs [oligohybridization areas] with ONPs . . . , exact position of each ONP in each OHA is established. OHAs prepared in this way with information on the position of each ONP 'product' . . . can be used for. . . sequence determination. ")

25. The hybridization areas can be hybridized with different targets and visualized all at once using a CCD camera having a high density of pixels (Drmanac, at col. 19, 1.30 to col. 20, 1. 18).

26. During processing of the HA (e.g., hybridization and washing) in detecting genomic DNA, the HA is in contact with a solution (e.g., Drmanac, at col. 22, 11.52-58).

27. The target DNA is denatured and binding to the complementary ONP is

performed (Drmanac, col. 18, 11.49-58); skilled persons in the art would have recognized that denaturation of the DNA produces single-stranded DNA.

28. A single hybridization area can be subdivided into "submatrices" (Drmanac, col. 19, 11.40 to col. 20, 1. 1) in which the particles carry a physical or chemical entity which enables recognition of the particle type (Drmanac, col. 21, 11.9-27). HA replicas (where the particles have the same position in each replica) can be utilized (Drmanac, col. 20, 11.1-3).

Application of Drmanac to claims

29. Drmanac describes "differing oligonucleotides . . . attached to different particles" as recited in claims 76 and 77 (FF 14, 15, and 17).

30. The particles are arranged in a monolayer (FF 20, 21), satisfying the limitation in claims 76 and 77 that the particles are in a "planar configuration."

31. The particles are attached to specific regions of the hybridization area (FF 28) and the exact position of each discrete particle in the hybridization area can be established (FF 24, 25). Thus, the particles are on a "defined area of a substrate" as recited in claims 76 and 105.

32. The particles described by Drmanac can be labeled with physical attributes or oligonucleotides (i.e., a "chemical characteristic")(FF 23), meeting the limitation recited in claims 76 and 77 that the "particles are encoded with a chemical or physical characteristic" that enables their identification.

33. The particles described by Drmanac are subjected to "fixations" (FF 20) on the substrate and the resulting hybridization areas can be "reused as classic filters" (FF 21, 22), indicating that the particles are "permanently anchored" by chemical bonding to the substrate on which the monolayer rests, as required by claims 76, 106, and 107, and also on the substrate surface as recited in claim 86.

34. Drmanac describes all elements of claims 76 and 86 (FF 29-33).

35. The DNA attached to Drmanac's particles can be derived from a

genomic library of random clones (FF 18) or corresponding oligonucleotides (FF 17) and thus are "compositionally random" as recited in claims 77 and 108.

36. The hybridization areas can be divided into submatrices on a single hybridization area in which the submatrices comprise different targets (FF 28; Drmanac, col. 11, l.58 to col. 20, l. 1). Thus, the particles are arranged in definite locations on certain parts of the substrate, but not others, and thus are "spatially non-random" as recited in claim 77.

37. The monolayer particle array of Drmanac is in contact with a solution at least during hybridization and washing (FF 26) which meets the claim 77 limitation of "a contiguous aliquot of solution" that is "placed on said planar configuration" of the array.

38. Drmanac describes all elements of claim 77 (FF 29, 30, 32, and 35-37).

39. The target DNA is denatured to form single-stranded DNA and hybridized to complementary genomic DNAs or oligonucleotides which are attached to the particles (FF 27) as required by claims 78 and 79.

40. The DNA attached to the particles can be "derived from a human being" (FF 16) as recited in claims 80 and 81.

41. The particles can be labeled with oligonucleotides to facilitate their recognition (FF 23). An oligonucleotide is a "chemical tag" and thus meets the requirement of claim 84.

42. Oligonucleotides can be labeled with visible markers *(see, e.g.,* Drmanac, at col. 21, l1.23-25) which are "capable of being interrogated optically" as recited in claim 85.

43. The genomic DNA or oligonucleotides ofDrmanac hybridize to their complement (FF 27), meeting the limitation of claim 88.

44. Claim 89 further recites that the claimed array comprises "a multiplicity of subarrays of oligonucleotides, wherein the location of each subarray on said substrate in combination with the encoding indicates the types of oligonucleotides located therein." This limitation is met by Drmanac's disclosure of HA submatrices, including replica HA in which the particles

have the same position in each replica (FF 28).

Claim 90

45. Claim 90 is a product-by-process claim for producing an array of oligonucleotides by steps of: 1) providing reservoirs comprising particles having attached oligonucleotides and 2) transferring the particles to a substrate to form a planar array where the particles are in known positions.

Appeal 2007-1624

Application 10/424,662

46. The claim recites that the particles have different oligonucleotides attached to them and are "encoded with a chemical or physical characteristic that uniquely identifies the particle type and oligonucleotide attached thereto."

47. The claim also requires that "the known positions of the reservoirs within the layout in combination with the encoding indicate the types of particles contained therein." Thus, when the process is carried out, the location of the particles on the array and the type of oligonucleotide attached to the particles are known.

48. The particles and their arrangement in a planar array produced by the process of claim 90 are described by Drmanac (FF 20 and 23), including the requirement of the claim that the location of the particles on the array and the type of oligonucleotide attached to the particles are known3(FF 24).

ANALYSIS

Anticipation requires a showing that each element of the claim is identifiable in a single reference. *See, e.g., Perricone* v.*Medicis Pharm. Corp.*, 432 F.3d 1368, 1375,77 USPQ2d 1321, 1325 (Fed. Cir. 2005). As described in detail above, Drmanac describes all the elements recited in claims 76-81, 84-86, 88, 89, and 105-108 and therefore anticipates them.

Claim 90 is a product-by-process claim. "[E]ven though product-byprocess claims are limited by and defined by the process, determination of patentability is based on the product itself." *In re Thorpe,* 777 F.2d 695,697,

3 This aspect would also be inferred from Drmanac' s disclosure that the HA

can be "reused as classic filters" (FF 22; Drmanac, at col. 7, 11.37-39). Once the HA is used once, and the particles in it are detected, the position of the particles and the oligonucleotides attached to the HA would be known. 227 USPQ 964, 966 (Fed. Cir. 1985). However, when the process steps

Confer a structure or characteristic on the product which distinguishes it from products made by other processes, the process steps should be considered. *See,* e.g., *In re Garnero,* 412 F.2d 276,279, 162USPQ 221, 223 (CCPA 1979). In this case, the array of oligonucleotides produced by the claimed steps of providing and transferring particles to a substrate results in an array having particles arranged in a planar array as described by Drmanac (FF 48). The claimed method steps do not appear to impart any structure or characteristic to the array which would distinguish it from the array described in Drmanac. Consequently, we find that Drmanac describes all elements of the array of oligonucleotides of claim 90, anticipating it.

SUMMARY

The rejections under §§ 102, 103, and 112, first paragraph, are reversed. The rejection of claim 79 under §112, second paragraph, is affirmed. A new ground of rejection over prior art is set forth over claims 76-81, 84-86, 88-90, and 105-108. Claims 82 and 83 are not subject to a rejection.

OTHER ISSUES

Upon return of the application to the technology center, we encourage the Examiner to determine whether claims 82 and 83 are unpatentable over Drmanac alone, or in combination with other prior art, including Eggers which was cited previously in combination with Fodor as making the subject matter of claims 82 and 83 obvious.

Allen (US 5,488,567, issued Jan. 30, 1996) is cited of interest for its teaching of an array of beads having attached DNA arranged in a planar

configuration on a microscope slide (at col. 15,11.56-60).

TIME PERIOD

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(l) provides

"Appellant may file a single request for rehearing within two months trom the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection of claim 10 pursuant to 37 C.F.R. § 41.50(b) (effective September 13,2004,69 Fed. Reg. 49960 (August 12,2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

37 C.F.R. § 41.50(b) provides a "new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 D.S.C. §§ 141 or 145with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the

prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any rehearing thereof.

No time period for taking any subsequent action in this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART: § *41.50(b)*

lbg

ERIC P. MIRABEL
BIOARRAY SOLUTIONS LLC
35 TECHNOLOGY DRIVE
WARREN NJ 07059